

REMARKS/ARGUMENTS

I. Introduction

This application is primarily directed to a send-reply label, to label sheet constructions which include a send-reply label and to methods of using them. The send-reply label generally includes a label that may be printed upon, removed and adhered to a first object to be mailed, and an inner label thereafter removed and placed on a second object to be mailed such that a recipient of the first package or envelope can simply remove the inner label off the package and place it on a reply package or envelope for mailing.

In the above-mentioned Decision on Appeal, the Board of Patent Appeals and Interferences affirmed the rejections of claims 1, 30 and 31 as anticipated by U.S. Patent 4,032,679 (Aoyagi), claims 1 and 13 as anticipated by U.S. Patent 3,914,483 (Stipek) and claim 28 as unpatentable over Stipek in view of U.S. Patent 6,170,879 (Rawlings), and reversed the rejection of claims 30 and 31 as anticipated by Stipek.

By this Amendment, claims 1-31 have been cancelled without disclaimer or prejudice and new claims 32 - 62 have been added.

A detailed discussion of the patentability of these new claims and particularly the new independent claims over Aoyagi and over Stipek and especially in view of the above-mentioned Decision on Appeal follows.

II. Support for the New Claims

For the examiner's convenience, examples (without limitation) of support for the new claims include FIGS. 1A, 1B, 4A and 4B, corresponding paragraphs in the specification and paragraphs [0006] and [0007].

III. The New Claims are Patentable for Reasons Set Forth in Paragraphs 21 and 22 of the Board's Decision

The Board in paragraphs 21 and 22 of its Decision said that claim 1 does not recite a "mailing address label" and claim 13 does not recite a "reusable mailing label" or a "send-reply label." In contrast, new claim 32 recites a reply mailing address label and a send-

reply mailing address label; claim 43 recites a send mailing address label and a reply-send mailing address label; claim 49 recites a send-reply mailing label assembly; and claim 61 recites a reply-send mailing label assembly. Accordingly, these claims patentably distinguish over the prior art of record.

IV. New Dependent Claims 35, 36, 51 and 52 Are Patentable Over the Prior Art

Unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. 112, sixth paragraph. *Penwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987), *cert denied*, 484 U.S. 961 (1988). *See, e.g.*, MPEP 2184 II. None of Aoyagi, Stipek and/or Rawlings, individually or in combination, discloses or performs the function of both the “second means” of “for adhering the ... label sheet construction” of dependent claims 35 and 51 and of the “third means” of “for allowing ... address label” of dependent claims 36 and 52. The relevant disclosures of the references have been explained in Applicant’s prior response papers in this application and are hereby incorporated by reference.

V. New Claims 53 and 61 Are Patentable Over the Prior Art

The prior art individually and/or in combination does not disclose the combination of the removing (a send-reply mailing label assembly or a reply-send mailing label assembly), adhering and mailing steps of mailing method claims 53 and 61, Applicant respectfully contends.

VI. Printed Matter Elements Are Entitled to Patentable Significance

Printed matter that is functionally related to the substrate can distinguish the invention from the prior art. *See, e.g., In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Here, the “printed matter” is “mailing address indicia,” for example, and the “substrate” is a “mailing article,” for example. It is thus respectfully contended that “mailing address indicia,” etc. are functionally related to a “mailing article,” etc. The “printed matter” should thus be accorded patentable significance.

VII. The Second Weakened Line Pattern in the Facestock Layer Is Not Disclosed by Aoyagi

New claims 32, 49, 53 and 61 include “a second weakened line pattern in the facestock layer” or similar/corresponding language. An example of this second weakened line pattern in the facestock layer is shown by line 16 in FIGS. 1A and 1B. Aoyagi, for example, does not disclose this weakened line pattern in the facestock layer: it does not have an adjacent facestock matrix. Thus, none of the claims is anticipated by Aoyagi.

VIII. The New Claims are Patentable for Additional Reasons Set Forth in the Board’s Decision

A. The Board on page 11 of its Decision said that method claim 31 is not interpreted “as requiring that the method steps be performed in the recited order.” In contrast, new independent method claims 53 and 61 specifically set forth an order for many of the steps, with the multiple uses of the word “after.” Thus, new claims 53 and 61 are patentable over the prior art.

B. The Board on page 11 of its Decision said that the claims do not include “any other language requiring use of the label as a reply label.” In contrast, new independent method claims 53 and 61 use the word “reply.”

C. The Board on page 12 of its Decision said that the “printed sub-label of Aoyagi may be removed from the label and stuck to another mailed item, such as an invoice (FF 5, 6, 16), to allow the recipient to ensure that the medication received corresponds to that identified on the invoice (*see* FF 8).” In contrast, new claims 53 and 61 recite that the mailing of the mailing article is with the inner label positioned in the outer label. Thus, at least new claims 53 and 61 are patentable over the prior art. See also, for example, new claims 36 and 52.

D. The Board in footnote 3, which refers to the Board’s rejections of method claims 30 and 31 over Aoyagi, interpreted “claim 31 as reading on a method in which the removing step occurs before the mailing step. Thus, claim 31 reads on a method in which a sub-

label is removed from a label on a package and attached to an invoice, prior to mailing the package. In this regard, we note that claims 30 and 31 do not preclude an additional step of printing mailing information on the outer label as well as the inner label, thus allowing simultaneous mailing of both first and second objects using the same label.”

In contrast, new claims 53 and 61 recite that the mailing of the mailing article is with the inner label positioned in the outer label and the claims also include the step of “removing the label assembly from the label sheet construction.” Thus, new claims 53 and 61 are patentable over the prior art. See also, for example, new claims 35, 36, 51 and 52.

IX. The Dependent Claims Are Patentable Over the Prior Art

All claims not specifically discussed above depend from independent claims discussed herein, and are allowable over the cited references for at least the reasons stated with respect to their corresponding independent claims.

CONCLUSIONS

In view of the foregoing, Applicant respectfully submits that all of the claims of the application as currently presented patentably distinguish over the cited references. Early issuance of the Notice of Allowance is thus in order.

The examiner is invited to call the undersigned patent counsel for Applicant to answer any questions or to discuss any further steps necessary for placing this application in condition for allowance.


The Commissioner is hereby authorized to charge any additional claim fees and any other fees which may be required, or credit any overpayment, to Deposit Account No. 50-3504. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

INTELLECTUAL PROPERTY LAW OFFICES OF
JOEL VOELZKE, APC

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By:

A handwritten signature in black ink, appearing to read 'Douglas N. Larson', written over a horizontal line.

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